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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,115	05/11/2006	Tokinobu Mitasaki	5259-000063/US/NP	1335
27572 7590 04/09/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
CHANG, AUDREY Y				
ART UNIT		PAPER NUMBER		
2872				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/579,115

**Applicant(s)**

MITASAKI ET AL.

**Examiner**

Audrey Y. Chang

**Art Unit**

2872

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21, 26, 32, 33, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 32, 33, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)
- Paper No(s)/Mail Date 3/16/2009
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Remark***

- This Office Action is in response to applicant's amendment filed on February 2, 2009, which has been entered into the file.
- By this amendment, the applicant has amended claims 21, 26, 32, 33, has canceled claims 1-20, 22-25, 27-31, 34-37 and has newly added claims 38-39.
- Claim 26 belongs to non-elected group and it has been indicated as "withdrawn" from consideration in the previous Office Action dated October 31, 2008. The claim status for this claim therefore is incorrect. Please correct in the subsequent communication.
- Claims 21, 32-33 and 38-39 remain pending in this application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 39 (newly submitted) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how does the reflection layer is structurally related to the laminated holographic medium produced. The scopes of the claim therefore are not clear. Furthermore, the phrase "the first diffraction grating layer, the recording layer and the recording layer are arranged in such a sequence" is totally confusing. What is the sequence referred here? It is also not clear the repeated "recording layer" is referred to what?

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 21, 32, 33, newly submitted claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent issued to Ishihara (JP 2003-050534).**

*Claims 21 and 32 have been significantly amended that necessitate the new grounds of rejections.*

Ishihara teaches, (with regard to amended claims 21 and 32), a *laminated holographic medium* that can be utilized as authentication device for copyright protection wherein the laminated holographic medium is produced by the method including the steps of providing an *identification information recording medium* that is formed by combining a recording layer (20B, Figure 8) which implicitly has an exposed surface, a gap layer (3C), a first core layer (2B), a first diffraction grating layer provided in the core layer (2B) for recording data and a first cladding layer (3B). Ishihara teaches the information recorded in the recording layer is in the form of recording mark transmittance or non-transmittance of light indicating the information data in accordance with a presence of a hole or a degree of remittance of the light, (please see the masked pattern for recording layer 20B). Ishihara further teaches that the laminated holographic medium is combined with a *recording medium* (323) including a second cladding layer (3), a second core layer and a second diffraction grating layer formed in the second core layer. It appears that the forming of the identification information recording medium including the step of forming information data on the recording layer (as shown in Figure 6) is independent and separated from the formation of the recording medium (323) including the second diffraction grating layer. It is noted that the recording medium (323) is formed by the steps as shown in Figure 3. It is either inherently true or obvious modification to one skilled in the art to form the laminated holographic medium by combining the identification information recording medium and the recording medium since

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they are made by different manufacture processes, to make two separately and then combine the two would reduce the interference between the two processes.

This reference has met all the limitations of the claims. It does not teach explicitly that the recording medium with the second cladding layer, second core layer and second diffraction grating layer is ROM type recording medium. However since the recording medium includes the essentially the same elements as a ROM type medium, the recording medium disclosed therefore includes the claimed ROM type recording medium. This reference also does not teach that the core layer and the diffraction grating layer are separate layers. However to either make them the same layer or different layers are considered to obvious matters of design choice to one skilled in the art, since them both function the same.

With regard to claims 33 and 38, Ishihara teaches laminated holographic medium that can serve as authentication device is formed by the methods disclosed and described above for claims 21 and 32.

With regard to claim 39, it is really not clear what is this reflection layer and how does it related to the laminated holographic medium, it really therefore cannot be examined with details. It is known in the holographic recording art to include reflection layer as desired to reflect the light to the proper path. The claimed sequence is really confusing and it really cannot be examined further.

### ***Response to Arguments***

5. Applicant's arguments filed on February 2, 2009 have been fully considered but they are not persuasive. The newly amended and newly submitted claims have been fully considered and they are rejected for the reasons stated above.

6. Applicant's arguments with regard to newly amended features have been fully addressed in the reasons for rejection stated above. The applicant is respectfully reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Many of the argued features are not explicitly claimed in the claims which therefore do not overcome the rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 571-272-2309. The examiner can normally be reached on Monday-Friday (9:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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